

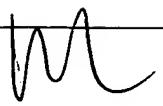


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,793	05/03/2002	Uwe Bunz	CERA-236	7286
24972	7590	10/05/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			RAMANA, ANURADHA	
666 FIFTH AVE			ART UNIT	PAPER NUMBER
NEW YORK, NY 10103-3198			3732	
DATE MAILED: 10/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/019,793	BUNZ ET AL. 
Examiner	Art Unit	
Anu Ramana	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 June 2004.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-18 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13-18 and 22-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

Claims 13 and 26 are objected to because of the following informalities.

In claim 13, line 5 and claim 26, line 2, it appears that "2" should be 3 since all cross sections disclosed by the Applicant have three or more sides.

In claim 13, line 5, "and" should be "or" to be in compliance with MPEP 2173.05(h)(II).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-14, 16-18, 22, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Gautier US 5,108,448).

Gautier discloses a sandwich insert having an inner spherical shell or sliding cup 3 made of a ceramic material, an intermediate spherical shell 4 or cover made from polyethylene or plastic that embraces the sliding cup 3 and an outer spherical metal shell 2 wherein the inner cup 3 has a stud 18 with a polygonal shape (4 sides) on the central axis of its outer surface for engagement with cover 4 by a snap-fit connection by projecting into housing 19 at the vertex or pole of cover 4 (col. 4, lines 32-40; col. 5, lines 10-30; col. 6, lines 17-35; and Figure 2).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 23, 25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautier (US 5,108,448).

Gautier discloses all elements of the claimed invention except for a stud having a polygonal shape (3, 5 or 6 sides), an oval shape or a length between 1 to 8 mm.

Regarding claims 15, 25 and 30, although Gautier is silent with respect to the length of stud 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a stud having an axial length of 1 to 8 mm or 2 mm, since it has been held that where the general conditions of a claim (stud 18 has a finite length) are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 23, 28 and 29, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made stud 18 with a polygonal shape having 3, 5 or 6 sides or an oval shape since it has been held that mere changes in shape are a matter of obvious design choice absent any persuasive evidence that the particular shape or configuration is significant. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

#### *Response to Arguments*

Applicant's arguments submitted under "REMARKS" in the response filed on June 20, 2004, with regard to claims 15, 23, 25 and 28-30 are not persuasive, since applicants have not provided any convincing showing that a polygonal shape (3, 5 or 6 sides) or an oval shape of the stud is anything more than a design choice. Applicants have not provided any showing that such limitations are "critical". *In re Cole*, 140 USPQ 230 (CCPA 1964); *In re Kuhle*, 188 USPQ 7 (CCPA 1975); *In re Davies*, 177 USPQ 381 (CCPA 1973). Mere arguments by counsel cannot take the place of evidence. *In re Cole*, 236 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); *In re Walters*, 168 f.2d 79, 80, 77 USPQ 609, 610 (CCPA 1948); et al.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*  
October 2, 2004

*Kevin Shaver*  
KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700